



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

M. VIKRAM RAO

Serial No.: **10/631,954**

Filed: **JULY 30, 2003**

Title: **"IMPROVED PARTICULATES AND
METHODS OF UTILIZING THESE
PARTICULATES IN SUBTERRANEAN
APPLICATIONS"**

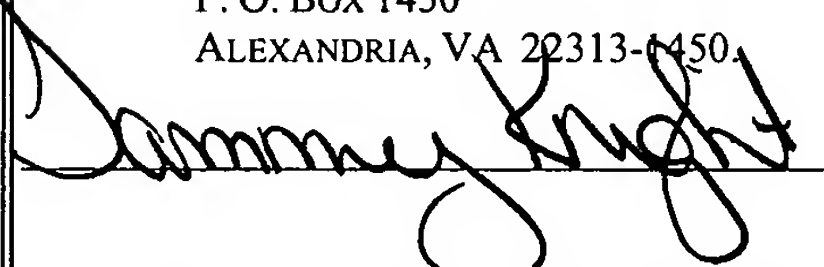
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Group Art Unit: **1773**

Examiner: **LE, HOA T.**

Atty. Docket No: **2003-IP-010829U1**

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| APPLICATION SERIAL No.: 10/631,954 | |
| GROUP ART UNIT: 1773 | |
| EXAMINER: LE, HOA T. | |
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal and the applicable fee. Applicant respectfully requests reconsideration of the application in light of the remarks set forth below.

REMARKS

In a Final Office Action dated May 12, 2006 (“Final Office Action”), the Examiner improperly rejected claims 1-17 under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 6,913,643 to Dejaiffe (“*Dejaiffe*”). The Examiner maintained these rejections in an Advisory Action dated August 10, 2006 (“Advisory Action”). The rejections of claims 1-17 contain clear legal and factual deficiencies.

Specifically, *Dejaiffe* does not disclose or teach every limitation of claims 1-17. Claims 1 and 10 require, in part, that the particulates recited therein comprise a “substantially spherical shape.” *Dejaiffe* does not, either expressly or inherently, disclose this limitation of claims 1 and 10, and thus, for at least that reason, *Dejaiffe* cannot anticipate these claims. Claims 2-9 and 11-17 depend from either claim 1 or claim 10, and thus are allowable for at least the same reasons.

1. *Dejaiffe* Does Not Anticipate Applicant’s Claims Because the Particulates Disclosed Do Not Necessarily Comprise a “Substantially Spherical Shape.”

Dejaiffe does not expressly disclose particulates having a substantially spherical shape. The Examiner does not dispute this. Moreover, after failing to discuss this element at all in the Final Office Action, the Examiner asserts for the first time in the Advisory Action that processes disclosed in *Dejaiffe* will “inherently produce particulates that are substantially spherical.” (Advisory Action at ¶ 1.) This is incorrect.

In order to inherently disclose an element of a claim, “the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” MANUAL OF PATENT EXAMINING PROCEDURE § 2112 (2005) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)).

The processes disclosed in *Dejaiffe* do not necessarily produce particulates having a substantially spherical shape. *Dejaiffe* discusses processes of generating certain particulates generically, and discloses ranges of possible amounts of starting materials that could be used to produce the particulates (*see, e.g., Dejaiffe* at col. 4, ll. 5-10), which may include an infinite number of specific amounts of those materials. *Dejaiffe* gives no indication to one skilled in the art that particulates produced using any of the processes disclosed therein necessarily will have a

substantially spherical shape. Moreover, there is no teaching in *Dejaiffe* of which processes would produce that shape. Even if particulates with a substantially spherical shape could be formed using these processes disclosed in *Dejaiffe*, one of ordinary skill in the art would not recognize it as such from the teachings contained in the reference. Thus, *Dejaiffe* inherently does not disclose, even inherently, substantially spherical particulates. See MANUAL OF PATENT EXAMINING PROCEDURE § 2112 (2005) (“must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill”).

Thus, the Examiner has not shown that the processes described in *Dejaiffe* will “necessarily” produce particulates having a substantially spherical shape, as required in Applicant’s claims, or that it would be so recognized by persons of skill in the art. Accordingly, *Dejaiffe* cannot anticipate Applicant’s claims.

2. The Examiner Improperly Relies on Applicant’s Specification to Explain the Prior Art to Show Inherent Disclosure.

The Examiner improperly relies on a portion of Applicant’s description of their invention in the specification in an attempt to provide an explanation for why the particulates disclosed in *Dejaiffe* necessarily are “substantially spherical” in shape:

This inherence fact is actually acknowledged by Applicant. At page 7, paragraph 25 of the instant specification, it’s stated: “When such combustion products are pelletized and sintered, they produce particulates that are substantially spherical and that exhibit specific gravities of below about 2.2.” Therefore, not only aggregates of *Dejaiffe* possess spherical shape, they also exhibit specific gravities of below 2.2 as claimed.

(Advisory Action at ¶ 1.)

The basis in fact and/or technical reasoning necessary to supply the teaching of a claim element inherent in the prior art *must* come from the extrinsic evidence available to a person of skill in the art. See MANUAL OF PATENT EXAMINING PROCEDURE § 2112 (2005). Applicant’s descriptions of the shape of the particulates generated according to their own invention does not inform or support the interpretation of *Dejaiffe* that the Examiner asserts. Moreover, the specific sentence to which the Examiner refers is found in the section of Applicant’s disclosure entitled “Description of Preferred Embodiments,” (*i.e.*, the description of Applicant’s invention) rather than the Background section or a section characterizing the prior

art. The Description of Preferred Embodiments section describes, among other things, the composition of certain combustion products, and then, with reference to those specific combustion products, states that, “[w]hen such combustion products are pelletized and sintered, they produce particulates that are substantially spherical and that exhibit specific gravities of below about 2.2.” (See Specification at ¶ [025].) Thus, this statement does not pertain to the prior art of Applicant’s invention, but rather describes the manner in which a person of skill should make or use Applicant’s claimed invention. Applicant’s disclosure of the claimed invention enables the production of particulates having a substantially spherical shape, but this enabling disclosure does not indicate or imply that the particulates disclosed in *Dejaiffe* or any other prior art reference necessarily will have this shape. Thus, the Examiner’s attempt to extrapolate from Applicant’s teaching to show that *Dejaiffe* inherently teaches Applicant’s invention is improper.

Thus, since *Dejaiffe* does not disclose each and every element of claims 1 and 10, *Dejaiffe* does not anticipate those claims. Moreover, claims 2-9 and 11-17 each depend, either directly or indirectly, from claim 1 or 10, and thus incorporate the limitations of claim 1 or 10 that *Dejaiffe* does not disclose. Therefore, claims 1-17 are allowable over *Dejaiffe*.

CONCLUSION

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Applicant further submits that the application is now in condition for allowance, and earnestly solicit timely notice of the same.

Applicant hereby petitions under the provisions of 37 C.F.R. § 1.136(a) for a two-month extension of time to file these papers, up to and including October 12, 2006.

The Commissioner is hereby authorized to debit should the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300, in the amount of \$450.00 for the fee under 37 C.F.R. § 1.17(a)(1) for the two-month extension of time to file this response. Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicant respectfully requests that the Commissioner accept this as a Petition Therefor, and directs that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Kent", written over a horizontal line.

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Date: October 5, 2006